

REMARKS

Claims 1-56 were pending and presented for examination in this application. In an Office Action dated September 25, 2006, claims 1-56 were rejected. Applicants thank Examiner for examination of the claims pending in this application and address Examiner's comments below.

Applicants are canceling claims 2, 8, 18, 26, 32, 42, 52, and 56 with this Amendment and Response. Applicants are amending claims 1, 3-4, 11-12, 19, 25, 27-28, 35-36, 43, and 53 in this Amendment and Response. These changes are believed not to introduce new matter, and their entry is respectfully requested. In making these amendments, Applicants do not concede that the subject matter of such claims was in fact disclosed or taught by the cited prior art. Rather, Applicants reserve the right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

In view of the Amendments herein and the Remarks that follow, Applicants respectfully request that Examiner reconsider all outstanding objections and rejections, and withdraw them.

Response to Rejections Under 35 USC 102(b) and 35 USC 103(a)

Examiner rejects claims 1, 3-14, 16-25, 27-38, and 40-48 under 35 USC § 102(b) as allegedly being anticipated by U.S. Patent Publication No. 2002/0059425 A1 to Belfiore, et al. ("Belfiore"). Examiner further rejects claims 2, 15, 26, 39, and 49-56 under 35 USC § 103(a) as allegedly being unpatentable in view of Belfiore and U.S. Patent Publication No. 2004/0267700 A1 to Dumais, et al. ("Dumais").

Independent claims 1 and 25, rejected under 35 USC § 102(b), have been amended to now include limitations previously found in dependent claims 2 and 26, rejected under 35 USC § 103(a). For purposes of clarity and convenience the rejections under 35 USC § 102(b) and 35 USC § 103(a) will be addressed together. The rejections are now respectfully traversed.

Representative claim 1, as amended, recites a method comprising:

- determining an occurrence of a condition indicating at least one transfer of an email message by an email application, wherein determining the occurrence of the condition is external to the email application;
- identifying event data associated with the email message;
- compiling an email event from at least some of the event data;
- associating the email event with a conversation based at least in part on the event data;** and
- storing the email event, **the association with the conversation**, and the email message.

Claim 25 and 56 recite a computer readable medium and system respectively for performing steps similar to claim 1. Claim 49, in its original form, also recites steps similar to claim 1.

The claimed invention determines the occurrence of a condition that indicates a transfer of an email message by an email application. The occurrence of the condition is determined external to the email application. Event data associated with the email message is identified and an email event is compiled from the event data. The email event is associated with a conversation based at least in part on the event data and the email event, email message, and association with the conversation are stored. This method is advantageous because, for example, associating the email event with a conversation beneficially provides a convenient organization of past email correspondences.

The claimed invention would not be obvious to a person of ordinary skill in the art considering the references either alone or in combination because neither reference discloses or suggests associating an email event with a conversation, as claimed. Belfiore discloses a distributed computing services platform. A server communicates to various client devices using data structures that follow a schema such that the meaning of the data is implied by the structure. Specifically, Belfiore discloses using an eXtensible Markup Language (XML) to facilitate communication between servers and/or client devices.

Examiner relies on cited paragraph [0111] of Belfiore as allegedly disclosing associating an email event with a conversation. However, in the cited section, Belfiore merely discloses a user interface for setting message priorities, such as setting a preference indicating that messages from a boss should always be given high priority. Setting message priorities based on a sender (e.g. a boss) is different than associating messages with a conversation. A message from a boss is at best associated with a sender and a priority setting and is not associated with a conversation which would comprise, for example, a chain of previously associated messages.

Examiner further incorrectly indicates that associating an email event with a conversation is disclosed in paragraphs [0102], [0105], and [0267] of Belfiore. However, the cited sections do not even appear to be related to the claimed invention. Paragraph [0102] discloses an example of an “action menu” that allows a user to click on an address and find a map, address label, or contact list. Paragraph [0105] refers to a command line feature of a user interface that allows a user to type natural language commands. Paragraph [0267] describes an example scenario related to message notifications. Thus, the cited sections do

not mention or even suggest associating the email event with a conversation based at least in part on the event data.

Dumais also does not disclose or suggest the claimed invention. Dumais discloses a system for information retrieval and reuse in which information from various information sources are indexed in a data store. Dumais does not mention or suggest associating an email event with a conversation based at least in part on the event data.

The rejections to the claims are further improper because Examiner has not met the prima facie burden of demonstrating that the cited references disclose or suggest the limitations of each of the claims. In the 3rd paragraph of the Office Action, Examiner cites a number of sections of the reference but has not provided any explanation of how the cited portions correspond to the claims, as required by MPEP 707.05. For example, Examiner has not indicated what element in Belfiore corresponds to “the occurrence of the condition” or what element corresponds to “identifying the email message,” as recited in claim 1 prior to the amendments herein. Accordingly, if the rejection is maintained, Examiner is respectfully requested to explain the basis for the assertion that the cited references disclose or suggest each rejected claim element.

It is noted that the cited sections of Belfiore do not disclose the claimed invention. Of the cited sections in the rejection to claims 1 and 25, email messaging is only mentioned in paragraph [0006] and “Section L: Scenarios” of Belfiore. Paragraph [0006] discloses a conventional email messaging system merely as a background example of Internet use. “Section L” discloses a feature of converting between e-mail messages and voicemail messages that is different than what is claimed. Other cited sections do not even appear to be related to the claimed invention. For example, paragraph [0023] discloses a directory

component that provides for synchronization between various directories containing user information or security information.

Therefore, based on the above amendments and remarks, Applicants respectfully request that Examiner reconsider the rejection to claims 1, 25, 49 and 56 and withdraw them.

Conclusion

In sum, Applicants respectfully submit that claims 1, 3-7, 9-17, 19-25, 27-31, 33-41, and 43-55 as presented herein, are patentably distinguishable over the cited references. Applicants submit that the dependent claims not mentioned above incorporate the limitations of their respective base claims and are allowable for at least the same reasons. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them. In addition, Applicants respectfully invite Examiner to contact Applicants' representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,
DAVID B. AUERBACH, et al.

Date: January 25, 2007

By: /Brian Hoffman/

Brian M. Hoffman, Attorney of Record
Registration No. 39,713
FENWICK & WEST LLP
275 Battery St., Suite 1500
San Francisco, CA 94111
Phone: (415) 875-2484
Fax: (415) 281-1350

24207/10111/DOCS/1680312.4